

The Office Action of August 28, 2001, at the paragraph spanning pages 6 and 7, points to the After Final Amendment of January 10, 1994 in prosecution of Patent Application Serial No. 07/868,335 as deleting subject matter which cannot now be reclaimed. The Office Action further indicates that the subject matter surrendered in the amendment January 10, 1994 should be included in reissue claims 30-32 and 34-44. The Applicant disagrees that the recapture rule bars the reissue claims. As will be presented below, the reissue claims at issue do not represent an impermissible recapture of surrendered subject matter.

A brief summary of the relevant federal court decisions regarding the application of the recapture rule to reissue claims under 35 U.S.C. § 251 is provided. According to *In re Clement*, 131 F.3d 1464 (45 USPQ2d 1161), the recapture rule prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims. The decision in *In re Clement* summarizes *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996 (27 USPQ 2d 1521) and *Ball Corp. v. United States*, 729 F.2d 1429 (221 USPQ 289) as providing the following rules regarding reissue claims. If the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim. If the reissue claim is narrower in all aspects, the recapture rule does not apply, but other rejections may apply. If the reissue claim is as broad as or broader than the canceled or amended claim in some aspects, but narrower in others, then (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; or (b) if the reissue claim is narrower in an

aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. The court went on to determine that the reissue claim at issue in *In re Clement* had been both broadened and narrowed in areas relevant to the prior art rejections. The court considered the scope of the broadening and narrowing aspects and concluded that because the reissue claim was broader than it was narrower in a matter directly pertinent to the subject matter that Clement had surrendered throughout the prosecution, the recapture rule barred the reissue claim.

Hester Industries Inc. v. Stein Inc., 142 F.3d 1472, (46 USPQ2d 1641, 1649) also agrees with *In re Clement* (at 1470) that if the reissue claim is as broad as or broader than the canceled or amended claim in some aspects, but narrower in others, the recapture rule may be avoided in some circumstances.

In a subsequent case, *B.E. Meyers & Co. v. United States*, 56 USPQ2d 1110 (US CtFedClis 2000), the U.S. Court of Federal Claims described circumstances in which the recapture rule did not apply to reissue claims which were broader than the issued claims. In *B.E. Meyers*, the applicant had surrendered subject matter during prosecution of its original patent for a lens system by adding limitations regarding one feature (the pulsing diode limitation) of the original claim. When the applicant realized that the feature itself was unnecessary to begin with, the applicant filed a reissue claim which removed from the claim the entire feature (the pulsing diode limitation) including the limitations (the substantially pulsing current limitations) which had been added to the originally unnecessary feature. The Court of Federal Claims agreed with the Examiner that the

reissue claim was a separate invention eligible for patent protection, independent of the unnecessary feature. The Examiner determined, and the court agreed, that the reissue claims to the lens system were separately patentable regardless of whatever type of pulsing circuitry might be used in combination with the lens system. Thus, although the reissue claims of *B.E. Meyers* were arguably broader in an aspect directly relevant to the surrendered subject matter, the recapture rule was found not to apply.

The *B.E. Meyers* decision appears to agree with the decision in *Ball*, in which the court found that if the reissue claims are narrower than the canceled claims, yet broader than the original patent claims, reissue claims are allowable if they are sought within 2 years after grant of the original patent.

It is submitted that the prosecution history of the claims at issue here is very similar to those of *B.E. Meyers*, and that the reasoning of *B.E. Meyers* in application of the recapture rule may be readily applied. Application of the recapture rule to each of the independent claims is addressed below.

Claims 29 and 33

The Applicant, in the Declaration in Support of a Reissue Application, identified that the originally filed Claim 12 in Patent Application Serial No. 07/868,335 was not rejected over any prior art, and that an independent claim of the same or similar scope was not pursued. New independent Claims 29 and 33 were therefore submitted in the present Reissue Application.

The scope of Claim 29, as presently amended, may be compared to issued independent Claim 1 and dependent Claim 12 to determine whether the recapture rule bars the claim. For convenience, reissue Claim 29, as it presently stands, and issued Claim 1 are presented in an Attachment to this submission, referenced to the paragraphs (a) - (d) below. Claim 29 is believed to be narrower than Claims 1 and 12 in some aspects, and broader in other aspects. The differences between Claim 29 and Claims 1 and 12 are as follows.

(a) With respect to the step of coding control information, Claim 29 recites that "said control information carries information for a specified group of mobile stations only at predetermined times". Claim 1 does not include this feature, although this feature is included in claim 12, as originally filed and as issued. Claim 12 was not amended during prosecution, nor did the Applicant argue that the Claim 12 features distinguished over the prior art. Indeed, no prior art was applied against Claim 12 during prosecution. In this aspect, Claim 29 may be considered narrower than Claim 1 and of equal claim scope compared to Claim 12. Thus, this aspect of reissue Claim 29 does not present a broadened claim scope which could trigger application of the recapture rule.

(b) Claim 29 recites with respect to coding control information, "wherein a duration of each of a succession of data blocks in the calling channel signal is equal to a duration of the speech coder's analysis period". This feature is not included in originally filed or issued Claim 1 or Claim 12. This feature was added to reissue Claim 29 in an amendment filed August 30, 1999. In this respect, Claim 29 is narrower than the issued

Claims, and does not present a broadened claim scope which could trigger application of the recapture rule.

(c) As originally filed, and as issued, Claim 1 also included the feature that the adding of said calling channel signal and said coded traffic signal to obtain a composite signal was accomplished "*using predetermined weighting factors*". (Italics added for emphasis.) Reissue Claim 29 includes the step of "adding said calling channel signal and said coded traffic signal to obtain a composite signal", but does not include the limitation of "*using predetermined weighting factors*". Thus, it may be considered that Claim 29 is broader than Claim 1 as filed and as issued in this aspect.

The limitation "*using predetermined weighting factors*" was not added during prosecution, nor was it amended during prosecution of the parent application in response to any prior art rejections. Nor did the Applicant argue that this language distinguished the claims over any prior art. Based on the prosecution history, it is clear that the subject matter relating to this limitation was not surrendered during earlier prosecution.

Therefore, deletion of the language "*using predetermined weighting factors*" does not broaden the claim in a way that attempts to recapture what was surrendered earlier.

According to *B.E. Meyers*, 56 USPQ2d at 1115, quoting *Mentor Corp.*, 998 F.2d 992, 996 (27 USPQ 2d 1521), if a reissue claims broadens a patent in a way that does not attempt to recapture what was surrendered earlier, the recapture rule does not apply. Therefore, the recapture rule may not be applied against Claim 29 in this respect.

(d) Issued Claim 1 recites "decoding said received signal in said mobile station to extract said control information *wherein said control information is used by said mobile*

station to determine if said mobile station is being called and to determine a phase of the calling signal, and "decoding said radio frequency signal in said mobile station using said phase of the calling channel signal to extract traffic information intended for said mobile station. Claim 29 recites "decoding said received signal in said mobile station to extract said control information" and "decoding said radio frequency signal in said mobile station to extract information intended for said mobile station.

The Office Action appears to consider that in this aspect, Applicants are attempting to recapture that which had previously been surrendered. Because a feature which had been included in the originally filed and issued claims is not included in the reissue claim 29, the reissue claims are broader in this respect. Nonetheless, it is believed that the recapture rule does not bar reissue Claim 29 on this basis.

The reissue Claim 29 includes a step of "decoding said received signal in said mobile station to extract said control information" however, does not include the feature which was originally filed in Claim 1 that "said control information is used by said mobile station to determine if said mobile station is being called". This feature is believed to have been unnecessary to the patentability of Claims 1 and 12. This language was not added during prosecution, nor did Applicants argue that it distinguished over any prior art. Indeed, the Office Action of March 13, 2001 in the present reissue application indicates that Claims 29 and 33, which do not include this feature, are free of prior art.

This situation is analogous to the situation addressed in *B.E. Meyers*, in which an unnecessary feature was removed from the issued claim in the reissue application, and the recapture rule did not apply. Because "said control information is used by said mobile

station" was an unnecessary limitation to the originally filed Claim 1, the additional limitations included in Claim 1, which were added in response to prior art rejections by the Patent Office, relate only to the unnecessary limitation. Claim 29 deletes any reference to the use of the control information by the mobile station. In doing so, Claim 29 necessarily also deletes any reference to determining whether the mobile station is being called, determining the phase of the calling signal, and using the phase of the calling signal channel to decode a radio frequency. Based on the court's decision that the recapture rule did not apply to reissue claims in an analogous situation in *B.E. Meyer*, it is believed that the recapture rule does not apply to reissue Claim 29.

In summary, the scope of Claim 29 can be considered to be broadened on some aspects and narrowed in other aspects. As discussed above, because reissue claim 29 deletes an unnecessary feature which was included in the originally filed claim 1 and deletes the further limitations to the unnecessary feature which were added during prosecution, it is believed that the recapture rule does not bar the reissue claim.

Reissue Claim 33, which claims an apparatus for transmitting control information, corresponds to issued Claim 24, and is similar to method Claim 29, which claimed a method for transmitting control information. Claim 24 was amended in the same manner as Claim 1, by the After Final Amendment submitted on January 10, 1994 in Application Serial No. 07/868,335. The above-identified reasons why the recapture rule should not bar issuance of reissue Claim 29, therefore also apply to reissue Claim 33.

Claims 30 and 34

Reissue Claims 30 and 34 are directed a method for paging a mobile station in a code division multiple access communication system and to a code division multiple access communication system for paging a mobile station, respectively. In comparison, issued claims 1-28 are directed to methods and apparatus for transmitting control information and user traffic signals from a first base station to a plurality of multiple stations in a code division multiple access systems. Thus, it is respectfully submitted that Claims 30 and 34 are separately patentable, and that these claims do not present broadening claims which could be subject to the recapture rule. As discussed in the Declaration in Support of a Reissue Application, the subject matter of Claim 30 and 34 is supported by the originally filed specification, however, was not claimed in the originally filed claims or during prosecution of the previous patent application.

In the event that the Examiner believes that Claims 30 and 34 are barred by the recapture rule, it is respectfully requested that further communication identify the manner in which Claims 30 and 34 are believed to be broader than the originally issued claims in an aspect relevant to prior art rejections.

Conclusion

For at least the foregoing reasons, Applicant respectfully submits that the present patent application is in condition for allowance. An early indication of the allowability of the present patent application is therefore respectfully solicited.

If the Examiner believes that a telephone conference with the undersigned would expedite passage of the present patent application to issue, he is invited to call on the undersigned at the number below.

Respectfully submitted,
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| Issued Claim 1 of U.S. Patent No. 5,377,183 | Reissue Claim 29, as amended on August 30, 1999 | Notes: |
|---|--|---|
| <p>1. A method for transmitting control information and user traffic signals from a first base station to a plurality of mobile stations in a code division multiple access communication system comprising the steps of:</p> | <p>29. A method for transmitting control information and user traffic signals from a first base station to a plurality of mobile stations in a code division multiple access communication system comprising the steps of:</p> | |
| <p>coding control information using a spread spectrum code unique to control information to form a calling channel signal;</p> | <p>coding control information using a spread spectrum code unique to control information to form a calling channel signal,</p> | |
| <p>--</p> | <p>wherein a duration of each of a succession of data blocks in the calling channel signal is equal to a duration of a speech coder's analysis period and</p> | <p>This text was added to Claim 29 by amendment on August 30, 1999.</p> |
| <p>--</p> | <p>wherein said control information carries information for a specified group of mobile stations only at predetermined times;</p> | <p>See paragraph (b) at page 5.</p> |
| <p>coding each user traffic signal using a spread spectrum code unique to each traffic signal;</p> | <p>coding each user traffic signal using a spread spectrum code unique to each traffic signal;</p> | |
| <p>adding said calling channel signal and said coded traffic signal using predetermined weighting factors to obtain a composite signal;</p> | <p>adding said calling channel signal and said coded traffic signal to obtain a composite signal;</p> | <p>See paragraph (c) at page 5.</p> |

| Issued Claim 1 of U.S. Patent No. 5,377,183 | Reissue Claim 29, as amended on August 30, 1999 | Notes: |
|---|--|--|
| modulating said composite signal on a radio frequency carrier to form a radio frequency signal; | modulating said composite signal on a radio frequency carrier to form a radio frequency signal; | |
| transmitting said radio frequency signal to said plurality of said mobile stations; | transmitting said radio frequency signal to said plurality of said mobile stations; | |
| receiving said radio frequency signal at at least one of said mobile stations; | receiving said radio frequency signal at at least one of said mobile stations; | |
| decoding said received signal in said mobile station to extract said control information wherein said control information is used by said mobile station to determine if said mobile station is being called and to <u>determine a phase</u> of the calling channel signal; and | decoding said received signal in said mobile station to extract said control information; and | Underlined text was added in Amendment filed January 10, 1994. See paragraph (d) on page 6. |
| decoding said radio frequency signal in said mobile station <u>using said phase of the calling channel signal</u> to extract traffic information intended for said mobile station. | decoding said radio frequency signal in said mobile station to extract traffic information intended for said mobile station. | Underlined text was added to Claim 29 by Amendment filed January 10, 1994. See paragraph (d) on page 6. |